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James E. Price

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POLSTER, LIEDER, WOODRUFF & LUCCHESI
12412 POWERSCOURT DRIVE SUITE 200
ST. LOUIS, MO 63131-3615

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LEWIS, KIM M

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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JAMES E. PRICE and TIMOTHY P. PHILIPP

Appeal 2009-004810
Application 10/568,131
Technology Center 3700

Decided:¹ June 10, 2009

Before DEMETRA J. MILLS, RICHARD M. LEBOVITZ, and STEPHEN
WALSH, *Administrative Patent Judges*.

WALSH, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a cosmetic bandage. The Patent Examiner rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The invention is a bandage that provides skin tone matching. (Spec. 1:9-15.) The “skin tone is applied to one side of an absorbent pad.” (*Id.*) “The absorbent pad is attached to a transparent strip so that the bandage appears very close to the skin tone of the user.” (*Id.*) Claims 1-11, which are all the pending claims, are on appeal. Appellants state that claims 2-6 stand or fall with claim 1, and claims 8-11 stand or fall with claim 7. (App. Br. 12.) *See* 37 C.F.R. § 41.37(c)(1)(vii). The representative claims read:

1. A cosmetic bandage comprising:
 - a transparent backing layer having a top side and a bottom side;
 - a transparent adhesive layer applied to the bottom side of the transparent backing layer;
 - an absorbent pad having a bottom side and a top side,
 - the top having a non-toxic pigmented composition applied to it so as to be derma matching and having a melanin likeness and appearance so as to substantially match human skin tones and colors,
 - the top side of the absorbent pad being attached to the bottom side of said backing layer so as to be visible therethrough; and
 - at least one removable strip applied to the bottom side of said backing layer and said pad.
7. A method of constructing a cosmetic bandage comprising:
 - forming an absorbent pad having a bottom side and a top side;
 - applying a non-toxic pigment to the top side of the pad; and
 - attaching the pigmented top side of the pad to a transparent backing layer.

The Examiner rejected the claims as follows:

- claims 1-6 under 35 U.S.C. § 103(a) over the combined teachings of Carmody,² Dow³ and Smith;⁴ and
- claims 7-11 under 35 U.S.C. § 103(a) over the combined teachings of Carmody and Dow.

OBVIOUSNESS

The Issues

The Examiner found that Carmody, Smith and Dow all described cosmetic bandages made to match skin tone. Carmody described a bandage similar to Appellants' in which a pigmented plastic strip was applied to an absorbent pad to match skin tone. Carmody, however, did not describe its adhesive as transparent, and did not state its pigment was non-toxic. The Examiner's position is that Smith's transparent adhesive and Dow's non-toxic pigments would have been obvious choices for the unspecified adhesive and the skin tone pigments that Carmody called for.

Appellants contend that at least one element in claims 1 and 7 is "not suggested, disclosed, or claimed in *Carmody*, *Smith*, or *Dow*." (App. Br. 9.) The missing element is said to be "an absorbent pad . . . the top having a non-toxic pigment composition applied to it." (*Id.*) Appellants dispute the Examiner's finding that "[Carmody's] pigmented strip is . . . a pigmented composition that is applied to absorbent pad (16)." (*Id.*)

² U.S. Patent No. 3,687,136, issued to Dewey Blain Carmody, Aug. 29, 1972.

³ U.S. Patent No. 5,120,325, issued to James E. Dow, Jr., Jun 9, 1992.

⁴ U.S. Patent No. 2,905,174, issued to Clifford W. Smith, Sep. 22, 1959.

Appellants argue that Smith teaches away from the invention “by discouraging the use of transparent backing.” (*Id.* at 11.) Appellants characterize the Examiner’s findings of motivation to use transparent adhesive and non-toxic pigments as merely identifying the purpose of those elements, and argues “[t]hey do not illustrate a suggestion, teaching, or motivation, to combine the elements.” (*Id.* at 12.)

Appellants argue that claim 7’s step of “applying a non-toxic pigment to the top of the pad” is not found in the prior art. (App. Br. 9.)

The issues are:

was Carmody’s pigmented strip a pigmented composition;

did the Examiner identify a reason why a person of ordinary skill in the art would have seen a benefit in using Smith’s transparent adhesive to make Carmody’s bandage;

did the Examiner identify a reason why a person of ordinary skill in the art would have seen a benefit in using Dow’s non-toxic pigment to make Carmody’s bandage; and

did the prior art disclose a step of applying a non-toxic pigment to the top of an absorbent pad?

Findings of Fact

Specification

1. The “Summary of the Invention” states: “[a]n absorbent pad having a top side and a bottom side is arranged so that one of the sides has a non-toxic pigment composition applied to it so as to be derma

- matching and having a melanin likeness and appearance.” (Amdt. dated Feb. 10, 2006, at p. 3 of 8.)
2. The “Summary of the Invention” further states: “[t]he composition is preferably applied by flood printing or a silk screening process, in which a speckle matrix arrangement is employed to provide improved skin matching capabilities.” (*Id.*)

Carmody

3. Carmody described a bandage having:
transparent backing **10** corresponding to Appellants’ backing layer;
pressure sensitive adhesive **12** corresponding to Appellants’ adhesive;
an absorbent pad **16** corresponding to Appellants’ absorbent pad;
a pigmented plastic strip **14** corresponding to Appellants’ pigmented composition; and
removable backing strips **18** corresponding to Appellants’ removable strip.
4. Carmody’s pigmented strip was of “suitable color to match the skin of the user.” (Col. 1, ll. 11-14.)
5. Carmody stated that the color of the pigmented strip “determines the color of the bandage.” (Col. 1, ll. 18-19.)
6. Carmody did not describe the adhesive **12** as transparent.
7. Carmody did not describe the pigmented plastic strip **14** as non-toxic.

Smith

8. Smith described a pigmented bandage made with transparent adhesive, that was “both attractive in appearance and substantially less noticeable.” (Col. 2, ll. 8-14.)

Dow

9. Dow described a skin-color matched adhesive bandage made with non-toxic pigment. (Col. 1, ll. 29-49.)

Principles of Law

“It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, . . . and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.”

In re Bond, 910 F.2d 831, 833 (Fed. Cir. 1990) (citation omitted).

A rejection for obviousness must include “articulated reasoning with some rational underpinning to support the legal conclusion.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The proper question to ask is whether a person of ordinary skill in the art, facing the wide range of needs created by developments in the field of endeavor, would have seen a benefit to combining the prior art teachings. *KSR*, 550 U.S. at 424; *see also In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004) (the desirability of the combination may arise from nature of the problem, teachings of references, or the ordinary knowledge of those skilled in the art).

[A] combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. . . . [I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond [his or her] skill.

KSR, 550 U.S. at 401.

A prior art reference is said to teach away from an applicant's invention "when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Analysis

The Examiner found that "Carmody discloses all features of the claim except that the [claimed] adhesive is transparent and that the pigment is non-toxic." (Ans. 8.) We agree. Carmody's pigmented plastic strip applied to the top of an absorbent pad is a "pigment composition" that claim 1 recites is applied to the top of an absorbent pad. Consistent with this interpretation, Appellants' Specification describes the absorbent pad as including a pigment composition applied to it. (FF1.) The Examiner reasonably understood Carmody's pigmented plastic strip to be a pigmented composition because the pigment was present in the plastic material from which the strip was made.

The Specification also describes preferred embodiments in which pigment is printed onto the pad. (FF2.) But during patent application

prosecution, claim terms are interpreted as having their broadest reasonable meaning consistent with the Specification, not as limited to preferred embodiments.

Appellants argue the Examiner did not find that Carmody's pigmented plastic strip is a pigment composition, but that the Examiner instead relied on an "equivalent element" theory. (App. Br. 9-10.) We disagree. The Examiner's discussion of "equivalency" was in the context of finding that Carmody's pigmented plastic strip and Dow's non-toxic pigment were equivalents. (Ans. 8.) The Examiner's "equivalence" rationale for replacing Carmody's pigmented strip with Dow's non-toxic pigments cited case law holding that such a substitution may be obvious even without an express suggestion. (*Id.*) Appellants' arguments about the "equivalency of a pigmented plastic strip and a pigment composition applied to a pad" (App. Br. 10), are thus misdirected. To repeat the Examiner's finding, Carmody's pigmented plastic strip applied to an absorbent pad is a pigment composition applied to an absorbent pad. That finding is consistent with the Specification's broad description of the claimed "pigment composition applied to it" language (FF1).

The Examiner's conclusion that it would have been obvious to use Dow's non-toxic pigment, where Carmody did not specify non-toxicity, had two rationales. We agree with the "equivalency" rationale already discussed. If Dow's non-toxic pigments were applied to Carmody's absorbent pad, they would have accomplished the same skin-tone matching function of "render[ing the] bandages inconspicuous on a user." (Ans. 8.) We also agree with the Examiner's motivation or suggestion rationale to

substitute Dow's non-toxic pigment to "ensure that the user is not poisoned by the pigment." (Ans. 4.) Appellants argue that the Examiner merely identified the "purpose" of the non-toxic pigment, which does "not illustrate a suggestion, teaching, or motivation, to combine the elements." (App. Br. 12.) We disagree. Those of ordinary skill in the art at the time of Appellants' invention would have appreciated the advantage the Examiner identified for non-toxicity and would have seen it as a benefit in pigmented bandages. *See Fulton*, 391 F.3d at 1200.

Appellants similarly fault the Examiner's finding of a suggestion to use transparent adhesive. (App. Br. 12.) The Examiner found that using Smith's transparent adhesive on Carmody's bandage would "render[] the adhesive invisible to the eye [and] so render the bandage inconspicuous." (Ans. 8.) The evidence supports that finding because it is the same advantage that Smith taught. (FF5.) We cannot agree that Smith's concern with unsightly and unattractive wound appearance taught away from using transparent adhesive on Carmody's bandage. (App. Br. 11.) Carmody's pigmented strip and absorbent pad hid the wound, regardless of the kind of adhesive used. On these facts, we do not agree there was any "teaching away." *See Gurley*, 27 F.3d at 553.

Appellants argue that claim 7's step of "applying a non-toxic pigment to the top side of the pad" is not found in the prior art. (App. Br. 9.) The Examiner found that "Carmody discloses applying a pigment in the form of a colored plastic strip (14)." (Ans. 5.) As explained above, the Examiner's reasoning is supported by the evidence. Appellants have not shown an error in the Examiner's finding.

CONCLUSIONS OF LAW

Carmody's pigmented strip is a pigmented composition;
the Examiner's finding of motivation for using Smith's transparent adhesive to make Carmody's bandage was sound; and

the Examiner's equivalency rationale and motivational rationale for substituting Dow's non-toxic pigment into Carmody's bandage were both sound; and

Carmody disclosed a step of applying a non-toxic pigment to the top of an absorbent pad.

SUMMARY

We affirm the rejection of claims 1-6 under 35 U.S.C. § 103(a) over the combined teachings of Carmody, Dow and Smith; and the rejection of claims 7-11 under 35 U.S.C. § 103(a) over the combined teachings of Carmody and Dow.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

cdc

POLSTER, LIEDER, WOODRUFF & LUCCHESI
12412 POWERSCOURT DRIVE SUITE 200
ST. LOUIS MO 63131-3615